

respectfully traverse the examiner's rejections for the reasons that will be set forth below.

Re the Section 112 rejections of claims 1-6 and 10-20:

The examiner rejected claims 1-6 and 10-20 under 35 U.S.C. §112, second paragraph, in that the term "'substantially the same' is a term of degree which renders the claim indefinite." See, page 2, section 4 of paper number 9. Applicants respectfully traverse this rejection.

The Court of Appeals for the Federal Circuit recently stated in Verve LLC v. Crane Cams Inc., 65 USPQ2d 1051 (Fed. Cir. 2002):

"It is well-established that when the term 'substantially' serves reasonably to describe the subject matter so that its scope would be understood by persons in the field of the invention, and to distinguish the claimed subject matter from the prior art, it is not indefinite."

In the present application, the use of the term "substantially" serves reasonably to describe the subject matter of the invention.

For example, and with reference to page 9, lines 5-16 of the specification, the invention is described as providing a volumetrically efficient architecture that allows a half-width cartridge read/write device (e.g., 34) and a cartridge storage magazine (e.g., 36) to be mounted within the same volumetric space as a full-width cartridge read/write device (e.g., 46). The specification goes on to state that the data storage capacity of the data storage system may thus be increased without requiring any additional volume or space by simply replacing a full-width cartridge read/write device (e.g., 46) with a half-width cartridge read/write device (e.g., 34) and a cartridge storage magazine (e.g., 36).

Additionally, on page 11, lines 1-15, the specification explains that one of the many advantages of the invention is that it allows the data storage capacity of the data storage system

to be increased without adding any additional volumetric space to the data storage system:

5 "By providing a volumetrically efficient architecture for mounting a half-width (i.e., half-height) cartridge read/write device (e.g., 34) and a cartridge storage magazine (e.g., 36), the present invention may allow a data storage system requiring less volumetric space to be selected which could not otherwise be used if additional volumetric space were necessary to
10 replace a full-width (i.e., full-height) cartridge receiving device with a half-width (i.e., half-height) cartridge read/write device and a cartridge storage magazine. Alternatively, additional space might be available for providing the data storage system with
15 other devices."

Thus, when read in light of the specification, the term "substantially," as used in the claims, serves to reasonably describe the subject matter of the invention and to allow its scope to be understood by persons in the field of the invention
20 to a degree sufficient to distinguish the claimed subject matter from the prior art. Accordingly, the term "substantially," as used in the pending claims, is not indefinite.

Legal Standard For Rejecting Claims
Under 35 U.S.C. §102

25 The standard for lack of novelty, that is, for "anticipation," under 35 U.S.C. §102 is one of strict identity. To anticipate a claim for a patent, a single prior source must contain all its essential elements. Hybritech, Inc. v. Monoclonal Antibodies, Inc., 231 USPQ 81, 90 (Fed. Cir. 1986).
30 Invalidity for anticipation requires that all of the elements and limitations of the claims be found within a single prior art reference. Scripps Clinic & Research Foundation v. Genentech, Inc., 18 USPQ2d 1001 (Fed. Cir. 1991). Furthermore, functional language, preambles, and language in "whereby," "thereby," and
35 "adapted to" clauses cannot be disregarded. Pac-Tec, Inc. v. Amerace Corp., 14 USPQ2d 1871 (Fed. Cir. 1990).

Argument:

Re the Rejections of Claims 1, 5, 14, 15, 17, and 20:

The examiner rejected claims 1, 5, 14, 15, 17, and 20 under 35 U.S.C. §102(b) as being anticipated by Menke. The examiner's rejections are improper in that Menke fails to disclose each and every limitation contained in the rejected claims.

Claim 1 requires that the first and second cartridge receiving devices "together occupy a volumetric space within the frame" and that the third cartridge receiving device occupies "substantially the same volumetric space within said frame as is occupied by said first and second cartridge receiving devices in said first component configuration." On page 4 of the office action, paper number 9, the examiner illustrates two different configurations of Menke in an attempt to show that Menke anticipates claim 1. However, these illustrations make clear that the third cartridge receiving device (e.g., item 4 in Figure 14, annotated) does not occupy "substantially the same volumetric space" within the frame as occupied by the first and second cartridge receiving devices (e.g., items 5 in Figure 15, annotated). To the contrary, the third device (e.g., item 4) clearly occupies significantly more volumetric space than is occupied by the first and second devices (e.g., items 5).

Because the third cartridge receiving device in Menke occupies more space (not substantially the same volumetric space) than is occupied by the first and second cartridge receiving devices, Menke cannot anticipate claim 1.

Dependent claim 5 is believed to be allowable over Menke in that it depends from claim 1, which is allowable over Menke.

Independent claim 14 is also allowable over Menke for substantially the same reasons as set forth above for claim 1. That is Menke fails to disclose a reconfigurable cartridge processing module having a frame that defines first and second component configurations wherein a "third cartridge receiving means" (in the second component configuration) occupies "substantially the same volumetric space within said frame as is

occupied by said first and second cartridge receiving means in said first component configuration." Clearly, in Menke, the third cartridge receiving device (e.g., item 4 in Figure 14, annotated) occupies more volumetric space than is occupied by the first and second devices (e.g., items 5 in Figure 15, annotated) in the first configuration. Accordingly, claim 14 is allowable over Menke.

Dependent claims 15 and 17 are believed to be allowable over Menke in that they depend from claim 14, which is allowable over Menke.

Method claim 20 is also allowable over Menke for substantially the same reasons as set forth above for claims 1 and 14. That is Menke does not disclose a method of defining a first component configuration by mounting first and second cartridge receiving devices to the frame and a second component configuration by mounting a third cartridge receiving device to the frame, the third cartridge receiving device "substantially replacing" the first and second cartridge receiving devices in the first configuration "so that a volumetric space occupied by said first and second cartridge receiving devices in the first component configuration is substantially occupied by said third cartridge receiving device in the second component configuration and vice-versa." Again, because Menke's third cartridge receiving device (e.g., item 4) occupies more volumetric space than the first and second devices (e.g., items 5), Menke fails to meet the limitations of method claim 20, thus cannot anticipate claim 20.

Re the Rejections of Claims 1-6 and 10-20:

The examiner rejected claims 1-6 and 10-20 under 35 U.S.C. §102(b) as being anticipated by Kersey. The examiner's rejections of these claims are improper in that Kersey fails to meet each and every limitation contained in the rejected claims.

Specifically, claim 1 requires that the first and second cartridge receiving devices "together occupy a volumetric space

within the frame" and that the third cartridge receiving device occupies "substantially the same volumetric space within said frame as is occupied by said first and second cartridge receiving devices in said first component configuration." These elements and limitations are not disclosed in or suggested by Kersey.

On page 5 of the office action, the examiner asserts that Figure 4b of Kersey corresponds to the first component configuration defined by claim 1. In this configuration, two tape drives 62 are positioned above a cartridge rack 74. The examiner regards only the lower tape drive 62 as being the "first cartridge receiving device." The examiner regards the cartridge rack 74 as being the "second cartridge receiving device." The examiner then asserts that Figure 4c of Kersey corresponds to the second component configuration defined by claim 1. In this configuration, the two tape drives 62 are absent, being replaced by a full-length cartridge rack 50. The examiner asserts that this full-length cartridge rack 50 corresponds to the "third cartridge receiving device" of claim 1.

However, these configurations, fail to meet the requirements of claim 1 in that the full-length cartridge rack 50 does not "occupy substantially the same volumetric space within said frame as is occupied by" the tape drive 62 and cartridge rack 74 of Figure 4b. Instead, the full-length cartridge rack 50 also occupies the space previously occupied by the upper tape drive 62. Stated another way, in Kersey, the third cartridge receiving device (e.g., Kersey's full-length cartridge rack 50) in the second configuration (Kersey's Figure 4c) occupies a space greater than that occupied by the first and second cartridge receiving devices (e.g., Kersey's lower tape drive 62 and rack 74) in the first configuration (Kersey's Figure 4b).

The examiner also defines another pair of first and second configurations of Kersey in an attempt to buttress the rejections of the claims 1, 2, 4, 10, 11, 13, 14, 19, and 20. See page 6 of the office action, paper number 9. In this second pair of first and second configurations, the examiner defines a first

configuration wherein two devices 62 comprise the first cartridge receiving device and wherein a shortened cartridge rack 74 comprises the second cartridge receiving device. The examiner then defines a second configuration wherein four devices 62
5 comprise the third cartridge receiving device. However, this second pair of first and second configurations also fail to anticipate any of the pending claims in that the third cartridge receiving device (i.e., the four devices 62) still fail to occupy substantially the same volumetric space occupied by the first and
10 second cartridge receiving devices (i.e., the two devices 62 and the shortened rack 74). To the contrary, in this second proposed pair of configurations, the third cartridge receiving device occupies less volumetric space than the first and second cartridge receiving devices.

15 Because Kersey does not meet all of the limitations recited in claim 1, that is, because Kersey does not disclose or suggest an arrangement wherein first and second cartridge receiving devices "together occupy a volumetric space within said frame" and wherein a third cartridge receiving device occupies
20 "substantially the same volumetric space within said frame as is occupied by said first and second cartridge receiving devices in said first component configuration," Kersey cannot anticipate claim 1.

25 Dependent claims 2-6 are believed to be allowable over Kersey in that they depend from claim 1, which is allowable over Kersey.

Kersey also fails to disclose each and every element and limitation contained in claim 10. That is, Kersey fails to disclose a reconfigurable cartridge processing module wherein a
30 "third cartridge device in said second component configuration" substantially replaces "said first and second cartridge receiving devices in said first component configuration and vice-versa, so that a volumetric space occupied by said first and second cartridge receiving devices in said first component configuration
35 is substantially occupied by said third cartridge receiving

'device in said second component configuration and vice-versa.'" Accordingly, claim 10 is allowable over Kersey.

Dependent claims 11-13 are believed to be allowable over Kersey in that they depend from claim 10, which is allowable over Kersey.

Claim 14 also defines subject matter that is not disclosed by Kersey. That is, Kersey does not disclose a reconfigurable cartridge processing module wherein a "third cartridge means in said second component configuration" substantially replaces "said first and second cartridge receiving means in said first component configuration and vice-versa, so that a volumetric space occupied by said first and second cartridge receiving means in said first component configuration is substantially occupied by said third cartridge receiving means in said second component configuration and vice-versa." Accordingly, claim 14 is allowable over Kersey.

Dependent claims 15-19 are believed to be allowable over Kersey in that they depend from claim 14, which is allowable over Kersey.

Method claim 20 is also allowable over Kersey for substantially the same reasons as set forth above for claims 1 and 14. That is Kersey fails to disclose a method of defining a first component configuration by mounting first and second cartridge receiving devices to the frame and a second component configuration by mounting a third cartridge receiving device to the frame, the third cartridge receiving device "substantially replacing" the first and second cartridge receiving devices in the first configuration "so that a volumetric space occupied by said first and second cartridge receiving devices in the first component configuration is substantially occupied by said third cartridge receiving device in the second component configuration and vice-versa." Again, because Kersey's third cartridge receiving device occupies either more or less volumetric space than the first and second devices (depending on the particular configuration pair that is chosen), Kersey fails to meet the

limitations of method claim 20, thus cannot anticipate claim 20.

Finally, in section 8 (entitled "Response to Arguments") of paper number 9, the examiner asserts that the limitation "occupy substantially the same volumetric space" is indefinite, thus should be interpreted broadly. Indeed. The examiner has taken the term "substantially the same" to mean anything, either more or less space, as may be required to support the examiner's rejections. As explained above, the term "substantially the same" is sufficiently definite under the test articulated by the Court of Appeals for the Federal Circuit in Verve, supra. The term "substantially the same" means what it says and serves to reasonably describe the subject matter of the invention and to allow its scope to be understood by persons in the field of the invention to a degree sufficient to distinguish the claimed subject matter from the prior art.

Applicants believe that all of the claims pending in this patent application are allowable and that all other issues raised by the examiner have been rectified. Therefore, applicants respectfully request the examiner to reconsider her rejections and to grant an early allowance. If any questions or issues remain to be resolved, the examiner is requested to contact the applicants' attorney at the telephone number listed below.

Respectfully submitted,

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